



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,331	05/04/1999	GEORGE VICTOR GUYAN	AND1P067	1963

7590 12/03/2001

HICKMAN STEPHENS & COLEMAN LLP
PO BOX 52037
PALO ALTO, CA 943030746

EXAMINER

ROBERTSON, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2163

DATE MAILED: 12/03/2001

7

Please find below and/or attached an Office communication concerning this application or proceeding.

146

Office Action Summary

Application No.

09/305,331

Applicant(s)

GUYAN ET AL.

Examiner

Dave Robertson

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This action is responsive to the amendments filed 9/17/01. Claims 1, 8, and 15 are amended. Claims 1-21 are pending.
2. Applicant has amended claims 1, 8, and 15 to delineate *tasks* handled by the invention as *insurance claim processing* tasks and receiving tasks that achieve *the processing of an insurance claim*.
3. Applicant does not amend claims 7, 14, and 21 nor does Applicant provide a response to the rejections of these claims under 35 U.S.C. 112, second paragraph. Furthermore, the amendment to claims 1, 8, and 15 necessitates an additional rejection under 35 U.S.C. 112 for claims 7, 14, and 21 for lack of antecedent basis (see below).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 7, 14, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *In Ex Parte Lyell 17 USPQ2d 1548 (Bd. PA&I 1990)*.

Claims 7, 14, and 21 recite the limitation "*the goal is insurance-related*." It is unclear as to the metes and bounds of this limitation. A broad interpretation of *insurance-related* encompasses all structures and activities where some portion thereof may be covered by a contractual guarantee against loss due to some adverse event. A narrow interpretation restricts insurance-related to the

Art Unit: 2163

insurance claim processing functions disclosed in the specification which only includes such functions but does not specifically exclude a broader interpretation.

6. **Claims 7, 14, and 21** recite the limitation *wherein the goal is insurance relate*". There is insufficient antecedent basis for this limitation in the claim. Amendments to claims 1, 8, and 15 removed the previously valid antecedent basis [*a goal upon completion*].

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-7 and 15-22** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by TODD in Microsoft® Exchange Server 5.5 Unleashed, 1998.

As to **claim 1**, in reference to the claimed invention, TODD discloses:

Claimed invention:

1. A computer program embodied on a computer readable medium for developing component based software capable of handling tasks, comprising:

a data component that stores, retrieves and manipulates data utilizing a plurality of functions;

a client component including:

an adapter component that transmits and receives data to/from the data component,
a business component that serves as a data cache and includes logic for manipulating the data, and

a controller component adapted to handle events generated by a user utilizing the business component to cache data and

Reference discloses:

TODD teaches the computer program Microsoft Exchange Server, a component-based software system capable of handling tasks (see Exchange Server Components, pages 8-11, and tasks in client software description, page 357).

See Information Store (IS) component, page 43.

Messages contain data that are stored, retrieved and manipulated using a plurality of functions.

See Outlook 97 client, page 357.

See Connectors component, page 52.

See Message Transfer Agent, page 48, and SMTP component logic, page 473-4, that caches and manipulates data using logic (messages) prior to relaying.

See Event Services component, page 50.

Art Unit: 2163

the adapter component to ultimately persist data to a data repository, wherein the client component is adapted for receiving a plurality of tasks that achieve a goal upon completion, allowing users to add new tasks that achieve the goal upon completion, allowing the users to edit the tasks, and generating a historical record of the tasks that are completed.

See Information Store (IS), page 43.

See Outlook client, tasks, page 357.

The addition, editing, and archiving of tasks is an inherent function of the Outlook 97 client.

As to **claim 2**, TODD teaches a workflow mechanism within Microsoft Exchange Server where *provided tasks are generated based on characteristics of a scenario and a set of rules embodied in a flow template*. Exchange Server generates tasks in its Workflow component based on a series of steps to be carried out to achieve a specific goal or *scenario* and the implicit set of rules designed into the flow. See discussion of Workflow within Exchange Server, pages 909-913.

As to **claim 3**, TODD teaches a client component Outlook as capable of handling tasks. Official notice is taken that Outlook 97 *is further adapted for providing indications of levels of importance of the tasks* by the assignment of a user selectable *priority* field to each task.

As to **claim 4**, TODD teaches a client component Outlook 97 *is further adapted for allowing the users to share the tasks with other applications*. Exchange Server is compliant with OLE 2.0 (Object-linking and Embedding, version 2.0) and allows tasks including tasks in a flow template, to be shared with other applications. Official notice is taken that it is old and well-known in the art that OLE allows applications to share in the processing of an another applications data.

As to **claim 5**, TODD teaches a client component Outlook 97 *is further adapted for automating a portion of work needed to complete the tasks*. Outlook 97 is inherently a *computerized electronic machine* (automated, Merriam-Webster Dictionary) for managing tasks...

Art Unit: 2163

As to claim 6, TODD teaches a client component Outlook 97 where *the portion of the work automated is writing correspondence*. Email is writing correspondence (*see page 448*) and that writing of correspondence is automated (claim 6 depends on claim 5).

As to claim 7, TODD teaches a workflow capability that includes the capability to develop flows where the *goal is insurance-related*. See page 909, "*There are flow templates for a wide range of tasks, from credit approval to customer service and sales.*"

Claims 15-21 being substantially similar and parallel, respectively, to rejected claims 1-7 above, are therefore also rejected over TODD for reasons stated above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over TODD in Microsoft® Exchange Server 5.5 Unleashed, 1998.

As to claim 8, in reference to the claimed invention, TODD discloses:

Claimed invention:

8. *A computer program embodied on a computer readable medium for creating a component based architecture capable of handling tasks, comprising:*

a user interface form code segment adapted for collecting data from a user input;
a business object code segment adapted for caching data;
an adapter code segment adapted for transmitting data to a server; and
a controller component code segment adapted for handling events generated by the user interacting with the user interface code segment,
creating one or more business objects, interacting with the adapter component to add, retrieve, modify, or delete business objects, and
wherein the computer program is adapted for receiving a plurality of tasks that achieve a goal upon completion, providing validation within a logic unit of work, containing logic to interact with the business component,
allowing users to add new tasks that achieve the goal upon completion,
allowing the users to edit the tasks, and
generating a historical record of the tasks that are completed.

Reference discloses:

TODD teaches the computer program Microsoft Exchange Server, a component-based software system capable of handling tasks (see Exchange Server Components, pages 8-11, and *tasks* in client software description, page 357).

The Outlook 97 client code segment collects data from user input.

See Message Transfer Agent, page 48.

See Connectors component, page 52.

The controller component for handling user events is an inherent part of the Outlook 97 client.

Outlook 97 creates business objects. Adding, retrieving, modifying and deleting business objects

See Outlook client, tasks, page 357.

Exchange Server validates the email address of a message against a directory of valid names (see page 397).

The addition, editing, and archiving of tasks is an inherent function of the Outlook 97 client.

However, TODD does not expressly disclose:

providing dirty flag processing to notify a user of change processing;

Art Unit: 2163

Official notice is taken that setting a dirty flag (or bit) as a value-change-indicator to mark and signal changes to data values in computer software was well-known in the art at the time of the invention (see Aoki, Alexander, and Yamato).

Claims 9-14, being substantially similar in their limitation on claim 8, as are claims 2-7, respectively, on claim 1, are therefore also rejected over TODD for reasons stated above.

Response to Arguments

11. Applicant's arguments filed 9/17/01 have been fully considered but they are not persuasive.

12. Applicant traverses the rejection of claims 1-7 and 15-22 under 35 U.S.C. 102(b) as being clearly anticipated by TODD in Microsoft® Exchange Server 5.5 Unleashed, 1998

Applicant argues that Todd in Microsoft Exchange Server 5.5 Unleashed does not teach the claimed invention. Examiner respectfully disagrees. Todd teaches a network-based, client/server software system for managing, among other things, tasks performed by users of Outlook 97 (the client). Applicant argues for distinction of the claimed invention using the specific language "data component", "client component", "logic for manipulating the data", etc. These concepts are old and well known in the art and in the prior office action, Examiner cited to equivalents to these components in the Microsoft literature. For example, one of ordinary skill in the art would recognize that an *information store component* is a data component; that Outlook 97 is a "client component" for Microsoft Exchange (the server); and that software in general *caches data and includes logic for manipulating data*. Furthermore, *task* is understood by those in the art as both a software entity, a data structure, and the functional representation of

Art Unit: 2163

a task to be performed by a user of a task-oriented software system such as Microsoft Exchange/Outlook 97, and creating, adding, and storing an record of tasks are well known functions of such tools.

In response to applicant's assertion that recitation of *processing insurance claims* and the accompanying argument that *tasks are insurance-related* provides patentable distinction, Examiner respectfully notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). *In re Stencel* is directed to statement of purpose in the preamble. The claims in the present invention do not, by reciting an intended use of the invention, result in a structural difference between the claimed invention and the prior art. The functional limitations relating to how the different components ~~interactive~~ (differently) for the purpose of processing insurance claims are not recited in the claims.

13. Applicant traverses the rejection of claims 8-14 under 35 U.S.C. 103(a) as being obvious over TODD in Microsoft® Exchange Server 5.5 Unleashed, 1998.

Applicant argues that the same features of claims 1 and 15 and their dependents distinguish the invention over the prior art Todd. Examiner respectfully disagrees for reasons cited above.

Art Unit: 2163

Conclusion


14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (703) 306.5679. The examiner can normally be reached on M: 12:30p-8:30p, T-Th: 8:30a-8:30p, F: 8:30a-12:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


dcr
November 29, 2001


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100